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EXAMINER

CHANDLER, SARA M

ART UNIT

PAPER NUMBER

3693

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/045,632	Applicant(s) MILBERGER ET AL.	
	Examiner SARA CHANDLER	Art Unit 3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-8, 11, 12, 14-19, 22 and 24-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-8, 11, 12, 14-19, 22 and 24-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/12/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

This Office Action is responsive to Applicant's arguments and request for continued examination of application 10/045,632 (10/26/01) filed on 11/12/08.

Claim Interpretation

1. In determining patentability of an invention over the prior art, all claim limitations have been considered and interpreted as broadly as their terms reasonably allow. See MPEP § 2111.

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *In re Pruter*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). See MPEP § 2111.

2. All claim limitations have been considered. Additionally, all words in the claims have been considered in judging the patentability of the claims against the prior art. The following language is interpreted as not further limiting the scope of the claimed invention. See MPEP 2106 II C.

Language in a method claim that states only the intended use or intended result, but the expression does not result in a manipulative difference in the steps of the claim. Language in a system claim that states only the intended use or intended result, but does not result in a structural difference between the claimed invention and the prior art.

Art Unit: 3693

In other words, if the prior art structure is capable of performing the intended use, then it meets the claim.

Claim limitations that contain statement(s) such as “*if, may, might, can could*”, as optional language. As matter of linguistic precision, optional claim elements do not narrow claim limitations, since they can always be omitted.

Claim limitations that contain statement(s) such as “*wherein, whereby*”, that fail to further define the steps or acts to be performed in method claims or the discrete physical structure required of system claims.

USPTO personnel should begin claim analysis by identifying and evaluating each claim limitation. For processes, the claim limitations will define steps or acts to be performed. For products, the claim limitations will define discrete physical structures or materials. Product claims are claims that are directed to either machines, manufactures or compositions of matter. See MPEP § 2106 II C.

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) statements of intended use or field of use,
- (B) “adapted to” or “adapted for” clauses,
- (C) “wherein” clauses, or
- (D) “whereby” clauses.

See MPEP § 2106 II C.

3. Independent claims are examined together, since they are not patentable distinct. If applicant expressly states on the record that two or more independent and distinct

Art Unit: 3693

inventions are claimed in a single application, the Examiner may require the applicant to elect an invention to which the claims will be restricted.

Priority

Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed applications: (a) 09/613,615 filed 07/11/00; (b) 09/476,384 and (c) PCT/US01/22,179 fail to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Art Unit: 3693

Re Claims 24, 25 and 28: Not a proper method (i.e., process) claim.

In order for a method to be considered a "process" under 101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *In re Bilski*, 88 USPQ2d 1385, 1391 and 1396 (2008).

The broadest reasonable interpretation of the claimed invention includes the interpretation that the process is merely a series of steps or acts taken by human operators. In other words a middleman (i.e., "the payment enabler") interacting with a person who handles transactions on behalf of a payor and a person who handles transactions on behalf of a payee (i.e., "the handlers"). Applying that interpretation to the claims, the claimed invention would not be a proper method claim because it does not tie itself to another statutory class (such as a particular apparatus). Although the preamble makes reference to an "online system", it is interpreted as a nominal recitation of another statutory class.

Claim Objections

Claims 24, 25 and 28 are objected to because of the following informalities:

Re Claims 24, 25 and 28: The claims recite, "a bank handler." Should this be -- bank funds transfer handler --. Consistent terminology should be used.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 3693

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-8, 11-12, 14-19, 22 and 24-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re Claims 24, 25 and 28: Claim terms should be clearly defined. E.g., What are handlers and payment enablers? The meaning of the term “handler” and “payment enabler” is indefinite because of conflicting meaning/interpretations that can be given the term in light of applicant’s claims and/or specification. Are these (a) a structural means capable of performing specific functions or (b) a particular person performing specific functions (c) something else?

Dependant claims are further rejected based on the same rationale as the claims from which they depend.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

Art Unit: 3693

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 2-8, 11-12, 14-19, 22 and 24-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farris, US Pub. No. 2002/0082962. (Note: Farris claims benefit to and incorporates by reference in its entirety provisional application 60/221,042.)

Re Claims 24 and 2-8: Farris discloses a method for transferring a credit amount from a payor to a payee using a money order, the payor sending the credit amount to the payor through an online system comprising a payment enabler and a wide-area network, wherein a payor computer and a payee computer are in communication with the wide-area network, the method comprising:

the payment enabler receiving pay-out instructions, from the payor computer, wherein the pay-out instructions include a payee, a delivery location, and the credit amount, the credit amount having a first value (Farris, abstract, [0011] [0013][0020][0022] [0040] thru [0042] [0051] [0149] [0269] thru [0277] Inherently, pay-out instructions regarding the payee, delivery location and credit amount are received because a designated recipient (i.e., payee) receives the value (i.e., credit amount) at any location domestically or abroad including the device/location used by the payor (i.e., location); See 60/221,042, Figs. 1,3 and pgs. 1-5, 7-11, 13-15, 22-29, 40-43 Payment enabler = ETS/system for example on pgs. 3-4,. Payor/Payee = individuals for example on pgs. 1,5 and 7; Payor computer/Payee computer = machines or kiosks for example on pgs. 1,5 and 7; Payout

Art Unit: 3693

instruction- payee, delivery location, credit amount = designated recipient, location domestic or abroad and value for example on pgs. 26-27);

the payment enabler receiving, from the payor computer, a first choice for a first handler, the first handler comprising one of a debit card handler, a bank handler, and a credit card handler (Farris, abstract, [0011] [0013][0020][0022] [0040] thru [0042] [0051] [0149] [0151] thru [0153] [0264] [0269] thru [00277] [0280] [0282] thru [0283] [0285] [0288] [0290] thru [0291] [0298] [0305][0316] [0321] thru [0323] [0327] thru [0332] [0355] [0362] thru [0363]; See 60/221,042, Figs. 1,3 and pgs. 1-5, 7-11, 13-15, 22-29, 40-43 Payment enabler = ETS/system for example on pgs. 3-4,. Payor/Payee = individuals for example on pgs. 1,5 and 7; Payor computer/Payee computer = machines or kiosks for example on pgs. 1,5 and 7; Handler = types of payment and associated means for example on pgs. 3-4);

the first handler receiving the credit amount having the first value, from the payor, the first handler receiving the credit amount having the first value as one of a group consisting of a debit card, a bank funds transfer, or a credit card (Farris, abstract, [0011] [0013][0020][0022] [0040] thru [0042] [0051] [0149] [0151] thru [0153] [0264] [0269] thru [00277] [0280] [0282] thru [0283] [0285] [0288] [0290] thru [0291] [0298] [0305][0316] [0321] thru [0323] [0327] thru [0332] [0355] [0362] thru [0363]; See 60/221,042, Figs. 1,3 and pgs. 1-5, 7-11, 13-15, 22-29, 40-43 Payment enabler = ETS/system for example on pgs. 3-4,. Payor/Payee = individuals for example on pgs. 1,5 and 7; Payor computer/Payee computer = machines or kiosks for example on pgs. 1,5 and 7; Handler

Art Unit: 3693

= types of payment and associated means for example on pgs. 3-4; Conversion = Conversion for example on pgs. 23-27 and 29);

the payment enabler receiving the credit amount having the first value from the

first handler (Farris, abstract, [0271] thru [00277] [0284] [0290]; See 60/221,042, Figs.

1,3 and pgs. 1-5, 7-11, 13-15, 22-29, 40-43 Payment enabler = ETS/system for example

on pgs. 3-4,. Payor/Payee = individuals for example on pgs. 1,5 and 7; Payor

computer/Payee computer = machines or kiosks for example on pgs. 1,5 and 7; Handler

= types of payment and associated means for example on pgs. 3-4; Conversion =

Conversion for example on pgs. 23-27 and 29);

the payment enabler converting the credit amount from the first value to a second

value (Farris, abstract, [0271] thru [00277] [0284] [0290]; See 60/221,042, Figs. 1,3 and

pgs. 1-5, 7-11, 13-15, 22-29, 40-43 Payment enabler = ETS/system for example on pgs.

3-4, Conversion = Conversion for example on pgs. 23-27 and 29);

the payment enabler receiving a second choice of a money handler from the payee

computer (Farris, abstract, [0011] [0013][0020][0022] [0040] thru [0042] [0044][0051]

[0149] [0155] [0262] [0269] thru [00277] [0280] [0282] [0290] [0296] thru [0297] [0299]

[0301] thru [0302] [0335] thru [0337] [0343] thru [0344] [0356]; See 60/221,042, Figs.

1,3 and pgs. 1-5, 7-11, 13-15, 22-29, 40-43 Payment enabler = ETS/system for example

on pgs. 3-4,. Payor/Payee = individuals for example on pgs. 1,5 and 7; Payor

computer/Payee computer = machines or kiosks for example on pgs. 1,5 and 7; Handler

= types of payment and associated means for example on pgs. 3-4; Conversion =

Conversion for example on pgs. 23-27 and 29);

Art Unit: 3693

the payment enabler sending the pay-out instructions to the money handler (Farris, abstract, [0011] [0013][0020][0022] [0040] thru [0042] [0044][0051] [0149] [0155] [0262] [0269] thru [00277] [0280] [0282] [0290] [0296] thru [0297] [0299] [0301] thru [0302] [0335] thru [0337] [0343] thru [0344] [0356]; See 60/221,042, Figs. 1,3 and pgs. 1-5, 7-11, 13-15, 22-29, 40-43 Payment enabler = ETS/system for example on pgs. 3-4, Payout instruction- payee, delivery location, credit amount = designated recipient, location domestic or abroad and value for example on pgs. 26-27; Handler = types of payment and associated means for example on pgs. 3-4; Conversion = Conversion for example on pgs. 23-27 and 29);

the money order handler receiving the credit amount having the second value from the payment enabler (Farris, abstract, [0011] [0013][0020][0022] [0040] thru [0042] [0044][0051] [0149] [0155] [0262] [0269] thru [00277] [0280] [0282] [0290] [0296] thru [0297] [0299] [0301] thru [0302] [0335] thru [0337] [0343] thru [0344] [0356]; See 60/221,042, Figs. 1,3 and pgs. 1-5, 7-11, 13-15, 22-29, 40-43 Payment enabler = ETS/system for example on pgs. 3-4, Handler = types of payment and associated means for example on pgs. 3-4; Conversion = Conversion for example on pgs. 23-27 and 29);

the money order handler creating a money order according to the pay-out instructions, the money order paid with the credit amount of the second value (Farris, abstract, [0011] [0013][0020][0022] [0040] thru [0042] [0044][0051] [0149] [0155] [0262] [0269] thru [00277] [0280] [0282] [0290] [0296] thru [0297] [0299] [0301] thru [0302] [0335] thru [0337] [0343] thru [0344] [0356]; See 60/221,042, Figs. 1,3 and pgs. 1-5, 7-11, 13-15,

Art Unit: 3693

22-29, 40-43 Payout instruction- payee, delivery location, credit amount = designated recipient, location domestic or abroad and value for example on pgs. 26-27; Handler = types of payment and associated means for example on pgs. 3-4; Conversion = Conversion for example on pgs. 23-27 and 29;); and the money order handler providing the money order to the payee (Farris, abstract, [0011] [0013][0020][0022] [0040] thru [0042] [0044][0051] [0149] [0155] [0262] [0269] thru [00277] [0280] [0282] [0290] [0296] thru [0297] [0299] [0301] thru [0302] [0335] thru [0337] [0343] thru [0344] [0356]; See 60/221,042, Figs. 1,3 and pgs. 1-5, 7-11, 13-15, 22-29, 40-43 Payor/Payee = individuals for example on pgs. 1,5 and 7; Handler = types of payment and associated means for example on pgs. 3-4;).

Farris fails to explicitly disclose wherein the delivery location is a residence for the payee.

Regarding wherein the delivery location is a residence for the payee.

Official Notice Official Notice is taken that was old and well-known at the time the invention was made to associate a payee with the address that is used as a delivery locations.

Documentary Evidence

Thomas, US Pat. No. 6,173,272, see abstract, col. 4, line 24+ - col. 5, line 14; col. 5, lines 35-37; col. 7, lines 66+ - col. 8, line 17; col. 8, lines 24-34; col. 10, lines 13-24.

Cahill, US Pat. No. 6,181,837, see col. 7, lines 60+ - col. 8, line 8.

Shimada, US Pub. No. 20020194125.

Art Unit: 3693

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Farris to provide wherein the delivery location is a residence for the payee.

The claimed invention applies a known technique to a known device (method, or product) ready for improvement to yield predictable results. Thus, the claimed subject matter likely would have been obvious under KSR. *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396.

Re Claims 25, 11-12, 14-19 and 26-27: Farris discloses a method for transferring a credit amount from a payor to a payee using a money order, the payor sending the credit amount to the payor through an online system comprising a payment enabler and a wide-area network, wherein a payor computer and a payee computer are in communication with the wide-area network, the method comprising:

the payment enabler receiving pay-out instructions, from the payor computer, wherein the pay-out instructions include a payee, a delivery location, and the credit amount, the credit amount having a first value (Farris, abstract, [0011] [0013][0020][0022] [0040] thru [0042] [0051] [0149] [0269] thru [0277] Inherently, pay-out instructions regarding the payee, delivery location and credit amount are received because a designated recipient (i.e., payee) may receive the value (i.e., credit amount) at any location domestically or abroad including the device/location used by the payor (i.e., location); See 60/221,042, Figs. 1,3 and pgs. 1-5, 7-11, 13-15, 22-29, 40-43

Payment enabler = ETS/system for example on pgs. 3-4,. Payor/Payee = individuals for example on pgs. 1,5 and 7; Payor computer/Payee computer = machines or kiosks for

Art Unit: 3693

example on pgs. 1,5 and 7; Payout instruction- payee, delivery location, credit amount = designated recipient, location domestic or abroad and value for example on pgs. 26-27);

the payment enabler determining a first handler (Farris, abstract, [0011]

[0013][0020][0022] [0040] thru [0042] [0051] [0149] [0151] thru [0153] [0264] [0269] thru [00277] [0280] [0282] thru [0283] [0285] [0288] [0290] thru [0291] [0298] [0305][0316] [0321] thru [0323] [0327] thru [0332] [0355] [0362] thru [0363]; See 60/221,042, Figs.

1,3 and pgs. 1-5, 7-11, 13-15, 22-29, 40-43 Payment enabler = ETS/system for example on pgs. 3-4,. Payor/Payee = individuals for example on pgs. 1,5 and 7; Payor computer/Payee computer = machines or kiosks for example on pgs. 1,5 and 7; Handler = types of payment and associated means for example on pgs. 3-4);

the first handler receiving the credit amount having the first value, from the payor,

the first handler receiving the credit amount having the first value as one of a group consisting of a debit card, a bank funds transfer, or a credit card (Farris, abstract, [0011] [0013][0020][0022] [0040] thru [0042] [0051] [0149] [0151] thru [0153] [0264] [0269] thru [00277] [0280] [0282] thru [0283] [0285] [0288] [0290] thru [0291] [0298] [0305][0316] [0321] thru [0323] [0327] thru [0332] [0355] [0362] thru [0363]; See 60/221,042, Figs.

1,3 and pgs. 1-5, 7-11, 13-15, 22-29, 40-43 Payment enabler = ETS/system for example on pgs. 3-4,. Payor/Payee = individuals for example on pgs. 1,5 and 7; Payor computer/Payee computer = machines or kiosks for example on pgs. 1,5 and 7; Handler = types of payment and associated means for example on pgs. 3-4; Conversion =

Conversion for example on pgs. 23-27 and 29);

Art Unit: 3693

the payment enabler receiving the credit amount having the first value from the first handler (Farris, abstract, [0271] thru [00277] [0284] [0290]; See 60/221,042, Figs. 1,3 and pgs. 1-5, 7-11, 13-15, 22-29, 40-43 Payment enabler = ETS/system for example on pgs. 3-4,. Payor/Payee = individuals for example on pgs. 1,5 and 7; Payor computer/Payee computer = machines or kiosks for example on pgs. 1,5 and 7; Handler = types of payment and associated means for example on pgs. 3-4; Conversion = Conversion for example on pgs. 23-27 and 29);

the payment enabler creating a first stored value fund (Farris, abstract, [0011] [0013][0020][0022] [0040] thru [0042] [0044][0051] [0149] [0155] [0262] [0269] thru [00277] [0280] [0282] [0290] [0296] thru [0297] [0299] [0301] thru [0302] [0335] thru [0337] [0343] thru [0344] [0356] See 60/221,042, Figs. 1,3 and pgs. 1-5, 7-11, 13-15, 22-29, 40-43 Payment enabler = ETS/system for example on pgs. 3-4, Conversion = Conversion for example on pgs. 23-27 and 29);

the payment enabler storing the credit amount having the first value in the first stored value fund (Farris, abstract, [0011] [0013][0020][0022] [0040] thru [0042] [0044][0051] [0149] [0155] [0262] [0269] thru [00277] [0280] [0282] [0290] [0296] thru [0297] [0299] [0301] thru [0302] [0335] thru [0337] [0343] thru [0344] [0356]; See 60/221,042, Figs. 1,3 and pgs. 1-5, 7-11, 13-15, 22-29, 40-43 Payment enabler = ETS/system for example on pgs. 3-4, Conversion = Conversion for example on pgs. 23-27 and 29);

the payment enabler converting the credit amount from the first value to a second

Art Unit: 3693

value (Farris, abstract, [0271] thru [00277] [0284] [0290]; See 60/221,042, Figs. 1,3 and pgs. 1-5, 7-11, 13-15, 22-29, 40-43 Payment enabler = ETS/system for example on pgs. 3-4, Conversion = Conversion for example on pgs. 23-27 and 29);

the payment enabler determining a second handler to prepare a payment

instrument (Farris, abstract, [0011] [0013][0020][0022] [0040] thru [0042] [0044][0051] [0149] [0155] [0262] [0269] thru [00277] [0280] [0282] [0290] [0296] thru [0297] [0299] [0301] thru [0302] [0335] thru [0337] [0343] thru [0344] [0356] See 60/221,042, Figs. 1,3 and pgs. 1-5, 7-11, 13-15, 22-29, 40-43 Payment enabler = ETS/system for example on pgs. 3-4,. Payor/Payee = individuals for example on pgs. 1,5 and 7; Payor computer/Payee computer = machines or kiosks for example on pgs. 1,5 and 7; Handler = types of payment and associated means for example on pgs. 3-4; Conversion = Conversion for example on pgs. 23-27 and 29);

the payment enabler sending the pay-out instructions to the second handler (Farris, abstract, [0011] [0013][0020][0022] [0040] thru [0042] [0044][0051] [0149] [0155] [0262] [0269] thru [00277] [0280] [0282] [0290] [0296] thru [0297] [0299] [0301] thru [0302] [0335] thru [0337] [0343] thru [0344] [0356]; See 60/221,042, Figs. 1,3 and pgs. 1-5, 7-11, 13-15, 22-29, 40-43 Payment enabler = ETS/system for example on pgs. 3-4,. Payout instruction- payee, delivery location, credit amount = designated recipient, location domestic or abroad and value for example on pgs. 26-27; Handler = types of payment and associated means for example on pgs. 3-4; Conversion = Conversion for example on pgs. 23-27 and 29);

the second handler receiving the credit amount having the second value from the

Art Unit: 3693

payment enabler (Farris, abstract, [0011] [0013][0020][0022] [0040] thru [0042] [0044][0051] [0149] [0155] [0262] [0269] thru [00277] [0280] [0282] [0290] [0296] thru [0297] [0299] [0301] thru [0302] [0335] thru [0337] [0343] thru [0344] [0356]; See 60/221,042, Figs. 1,3 and pgs. 1-5, 7-11, 13-15, 22-29, 40-43 Payment enabler = ETS/system for example on pgs. 3-4, Handler = types of payment and associated means for example on pgs. 3-4; Conversion = Conversion for example on pgs. 23-27 and 29);

the second handler creating the payment instrument according to the pay-out instructions, the payment instrument paid with the credit amount of the second value (Farris, abstract, [0011] [0013][0020][0022] [0040] thru [0042] [0044][0051] [0149] [0155] [0262] [0269] thru [00277] [0280] [0282] [0290] [0296] thru [0297] [0299] [0301] thru [0302] [0335] thru [0337] [0343] thru [0344] [0356]; See 60/221,042, Figs. 1,3 and pgs. 1-5, 7-11, 13-15, 22-29, 40-43 Payout instruction- payee, delivery location, credit amount = designated recipient, location domestic or abroad and value for example on pgs. 26-27; Handler = types of payment and associated means for example on pgs. 3-4; Conversion = Conversion for example on pgs. 23-27 and 29); and

the second handler providing the payment instrument to the payee (Farris, abstract, [0011] [0013][0020][0022] [0040] thru [0042] [0044][0051] [0149] [0155] [0262] [0269] thru [00277] [0280] [0282] [0290] [0296] thru [0297] [0299] [0301] thru [0302] [0335] thru [0337] [0343] thru [0344] [0356]; See 60/221,042, Figs. 1,3 and pgs. 1-5, 7-11, 13-15, 22-29, 40-43 Payor/Payee = individuals for example on pgs. 1,5 and 7; Handler = types of payment and associated means for example on pgs. 3-4;).

Farris fails to explicitly disclose wherein the delivery location is a residence for the payee.

Regarding wherein the delivery location is a residence for the payee.

Official Notice Official Notice is taken that was old and well-known at the time the invention was made to associate a payee with the address that is used as a delivery locations.

Documentary Evidence

Thomas, US Pat. No. 6,173,272, see abstract, col. 4, line 24+ - col. 5, line 14; col. 5, lines 35-37; col. 7, lines 66+ - col. 8, line 17; col. 8, lines 24-34; col. 10, lines 13-24.

Cahill, US Pat. No. 6,181,837, see col. 7, lines 60+ - col. 8, line 8.

Shimada, US Pub. No. 20020194125.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Farris to provide wherein the delivery location is a residence for the payee.

The claimed invention applies a known technique to a known device (method, or product) ready for improvement to yield predictable results. Thus, the claimed subject matter likely would have been obvious under KSR. *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396.

Re Claims 28-30: Farris discloses a method for transferring a credit amount from a payor to a payee using a money order, the payor sending the credit amount to the payor through an online system comprising a payment enabler and a wide-area network,

Art Unit: 3693

wherein a payor computer and a payee computer are in communication with the wide-area network, the method comprising:

the payment enabler receiving pay-out instructions, from the payor computer, wherein the pay-out instructions include a payee, a delivery location, and the credit amount, the credit amount having a first value (Farris, abstract, [0011]

[0013][0020][0022] [0040] thru [0042] [0051] [0149] [0269] thru [0277] Inherently, pay-out instructions regarding the payee, delivery location and credit amount are received because a designated recipient (i.e., payee) may receive the value (i.e., credit amount) at any location domestically or abroad including the device/location used by the payor (i.e., location); See 60/221,042, Figs. 1,3 and pgs. 1-5, 7-11, 13-15, 22-29, 40-43

Payment enabler = ETS/system for example on pgs. 3-4,. Payor/Payee = individuals for example on pgs. 1,5 and 7; Payor computer/Payee computer = machines or kiosks for example on pgs. 1,5 and 7; Payout instruction- payee, delivery location, credit amount = designated recipient, location domestic or abroad and value for example on pgs. 26-27);

the payment enabler determining a first handler (Farris, abstract, [0011]

[0013][0020][0022] [0040] thru [0042] [0051] [0149] [0151] thru [0153] [0264] [0269] thru [00277] [0280] [0282] thru [0283] [0285] [0288] [0290] thru [0291] [0298] [0305][0316] [0321] thru [0323] [0327] thru [0332] [0355] [0362] thru [0363]; See 60/221,042, Figs. 1,3 and pgs. 1-5, 7-11, 13-15, 22-29, 40-43 Payment enabler = ETS/system for example on pgs. 3-4,. Payor/Payee = individuals for example on pgs. 1,5 and 7; Payor computer/Payee computer = machines or kiosks for example on pgs. 1,5 and 7; Handler = types of payment and associated means for example on pgs. 3-4);

Art Unit: 3693

the first handler receiving the credit amount having the first value, from the payor, the first handler receiving the credit amount having the first value as one of a group consisting of a debit card, a bank funds transfer, or a credit card (Farris, abstract, [0011] [0013][0020][0022] [0040] thru [0042] [0051] [0149] [0151] thru [0153] [0264] [0269] thru [00277] [0280] [0282] thru [0283] [0285] [0288] [0290] thru [0291] [0298] [0305][0316] [0321] thru [0323] [0327] thru [0332] [0355] [0362] thru [0363]; See 60/221,042, Figs. 1,3 and pgs. 1-5, 7-11, 13-15, 22-29, 40-43 Payment enabler = ETS/system for example on pgs. 3-4,. Payor/Payee = individuals for example on pgs. 1,5 and 7; Payor computer/Payee computer = machines or kiosks for example on pgs. 1,5 and 7; Handler = types of payment and associated means for example on pgs. 3-4; Conversion = Conversion for example on pgs. 23-27 and 29);

the payment enabler receiving the credit amount having the first value from the first handler (Farris, abstract, [0011] [0013][0020][0022] [0040] thru [0042] [0051] [0149] [0151] thru [0153] [0264] [0269] thru [00277] [0280] [0282] thru [0283] [0285] [0288] [0290] thru [0291] [0298] [0305][0316] [0321] thru [0323] [0327] thru [0332] [0355] [0362] thru [0363]; See 60/221,042, Figs. 1,3 and pgs. 1-5, 7-11, 13-15, 22-29, 40-43 Payment enabler = ETS/system for example on pgs. 3-4,. Payor/Payee = individuals for example on pgs. 1,5 and 7; Payor computer/Payee computer = machines or kiosks for example on pgs. 1,5 and 7; Handler = types of payment and associated means for example on pgs. 3-4; Conversion = Conversion for example on pgs. 23-27 and 29);

Art Unit: 3693

the payment enabler storing the credit amount having the first value in a first stored value fund, the first stored value fund associated with the payor (Farris, abstract, [0011] [0013][0020][0022] [0040] thru [0042] [0044][0051] [0149] [0155] [0262] [0269] thru [00277] [0280] [0282] [0290] [0296] thru [0297] [0299] [0301] thru [0302] [0335] thru [0337] [0343] thru [0344] [0356]; See 60/221,042, Figs. 1,3 and pgs. 1-5, 7-11, 13-15, 22-29, 40-43 Payment enabler = ETS/system for example on pgs. 3-4, Conversion = Conversion for example on pgs. 23-27 and 29);

the payment enabler converting the credit amount from the first value to a second value (Farris, abstract, [0271] thru [00277] [0284] [0290]; See 60/221,042, Figs. 1,3 and pgs. 1-5, 7-11, 13-15, 22-29, 40-43; See 60/221,042, Figs. 1,3 and pgs. 1-5, 7-11, 13-15, 22-29, 40-43 Payment enabler = ETS/system for example on pgs. 3-4, Conversion = Conversion for example on pgs. 23-27 and 29);

the payment enabler storing the credit amount having the second value in a second stored value fund, the second stored value fund associated with the payee (Farris, abstract, [0011] [0013][0020][0022] [0040] thru [0042] [0044][0051] [0149] [0155] [0262] [0269] thru [00277] [0280] [0282] [0290] [0296] thru [0297] [0299] [0301] thru [0302] [0335] thru [0337] [0343] thru [0344] [0356]; See 60/221,042, Figs. 1,3 and pgs. 1-5, 7-11, 13-15, 22-29, 40-43 Payment enabler = ETS/system for example on pgs. 3-4, Conversion = Conversion for example on pgs. 23-27 and 29);

the payment enabler receiving a choice of a second handler from the payee computer, the second handler one of a debit card handler, a bank handler, a credit card

Art Unit: 3693

handler, a promotion handler, or a money order handler (Farris, abstract, [0011] [0013][0020][0022] [0040] thru [0042] [0044][0051] [0149] [0155] [0262] [0269] thru [00277] [0280] [0282] [0290] [0296] thru [0297] [0299] [0301] thru [0302] [0335] thru [0337] [0343] thru [0344] [0356]; See 60/221,042, Figs. 1,3 and pgs. 1-5, 7-11, 13-15, 22-29, 40-43 Payment enabler = ETS/system for example on pgs. 3-4,. Payor/Payee = individuals for example on pgs. 1,5 and 7; Payor computer/Payee computer = machines or kiosks for example on pgs. 1,5 and 7; Handler = types of payment and associated means for example on pgs. 3-4; Conversion = Conversion for example on pgs. 23-27 and 29);

the payment enabler sending the pay-out instructions to the second handler (Farris, abstract, [0011] [0013][0020][0022] [0040] thru [0042] [0044][0051] [0149] [0155] [0262] [0269] thru [00277] [0280] [0282] [0290] [0296] thru [0297] [0299] [0301] thru [0302] [0335] thru [0337] [0343] thru [0344] [0356]; See 60/221,042, Figs. 1,3 and pgs. 1-5, 7-11, 13-15, 22-29, 40-43 Payment enabler = ETS/system for example on pgs. 3-4,. Payout instruction- payee, delivery location, credit amount = designated recipient, location domestic or abroad and value for example on pgs. 26-27; Handler = types of payment and associated means for example on pgs. 3-4; Conversion = Conversion for example on pgs. 23-27 and 29);

the payment enabler sending the credit amount having the second value from the second stored value account to the second handler (Farris, abstract, [0011] [0013][0020][0022] [0040] thru [0042] [0044][0051] [0149] [0155] [0262] [0269] thru [00277] [0280] [0282] [0290] [0296] thru [0297] [0299] [0301] thru [0302] [0335] thru

Art Unit: 3693

[0337] [0343] thru [0344] [0356]; See 60/221,042, Figs. 1,3 and pgs. 1-5, 7-11, 13-15, 22-29, 40-43 Payment enabler = ETS/system for example on pgs. 3-4, Handler = types of payment and associated means for example on pgs. 3-4; Conversion = Conversion for example on pgs. 23-27 and 29);

the second handler creating the payment instrument according to the pay-out instructions, the payment instrument paid with the credit amount of the second value; and the second handler providing the payment instrument to the payee (Farris, abstract, [0011] [0013][0020][0022] [0040] thru [0042] [0044][0051] [0149] [0155] [0262] [0269] thru [00277] [0280] [0282] [0290] [0296] thru [0297] [0299] [0301] thru [0302] [0335] thru [0337] [0343] thru [0344] [0356]; See 60/221,042, Figs. 1,3 and pgs. 1-5, 7-11, 13-15, 22-29, 40-43 Payor/Payee = individuals for example on pgs. 1,5 and 7; Handler = types of payment and associated means for example on pgs. 3-4).

Farris fails to explicitly disclose wherein the delivery location is a residence for the payee.

Regarding wherein the delivery location is a residence for the payee.

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Documentary Evidence

Art Unit: 3693

Thomas, US Pat. No. 6,173,272, see abstract, col. 4, line 24+ - col. 5, line 14; col. 5, lines 35-37; col. 7, lines 66+ - col. 8, line 17; col. 8, lines 24-34; col. 10, lines 13-24.

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Shimada, US Pub. No. 20020194125.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Farris to provide wherein the delivery location is a residence for the payee.

The claimed invention applies a known technique to a known device (method, or product) ready for improvement to yield predictable results. Thus, the claimed subject matter likely would have been obvious under KSR. *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396.

Response to Arguments

Double Patenting

Withdrawn in light of terminal disclaimer

Objections/112

Withdrawn in light of prior submitted amendment

Prior Art

(1) Application argues, the publication of Farris (2002/0082962) cannot be considered prior art under 35 U.S.C. § 102(e) because Farris was not filed before the invention of the present application.

Applicant's arguments have been fully considered but they are not persuasive.

Farris, US Pub. 2002/0082962 is a publication dated June 27, 2002 of application 09/917,439 filed July 27, 2001 and claims the benefit of provisional application 60/221,042 which was filed **July 27, 2000**. See citations supra regarding where support may be may be found in provisional application 60/221,042 for the limitations found in the claimed invention.

The present application 10/045,632 was filed October 26, 2001. The application is a CIP of each of (a) 09/613,615 filed July 11, 2000; (b) 09/476,384 filed December 30, 1999; and (c) PCT/US01/22,179 filed July 11, 2001. Although the application claims the benefit of these earlier filed applications, the claimed invention is not entitled to the earlier benefit dates because support cannot be found for the claimed invention in the earlier filed applications. Thus, the present application is entitled to its actual filing date of **October 26, 2001**.

Contrary to applicant's assertion, support for all claim elements must be found in the prior application in order for the claim to receive the benefit date of the prior application.

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent

Art Unit: 3693

application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994). See also MPEP 201.11.

As noted in the remarks below, this is not the case in the instant application.

Applicant's demonstration of where support may be found in the prior filed applications is piecemeal because it requires support from all three applications in order to cover the elements of the claimed invention.

The filing date of application 09/476,384 cannot be relied upon because as applicant admits, at least one limitation found in the claimed invention is not disclosed in 09/476,384 (e.g., the payment enabler converting the credit amount from the first value to a second value). See Applicant's Remarks, pg. 12, 11/12/08.

The filing date of application 09/613,615 cannot be relied upon at least one limitation found in the claimed invention is not disclosed in 09/613,615 (e.g., the payment, enabler receiving pay-out instructions, from the payor computer, the pay-out instructions include a payee, a residence address and the credit amount, the credit amount having a fast value; and the money order handler providing the money order to the payee, wherein, the money order is provided to the payee by sending the money order to the payee's residence address.) Contrary to applicant's remarks, the specified payout instructions cannot be found in 09/613,615. See Applicant's Remarks, pgs. 11, 11/12/08.

Even if applicant could claim benefit to PCT/US01/22,179, the application post-dates the earliest date for which the prior art reference may claim benefit.

It is also noted that applicant has not submitted an affidavit or declaration with support swearing behind Farris.

(2) Applicant argues, the claimed invention should not be rejected under 102..

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

(3) Applicant argues, the office action does not note the specific components of the payment system within the provisional application.

Applicant's arguments have been fully considered but they are not persuasive.

The prior art of record is not 'complex' and it's teachings would be obvious to one of ordinary skill in the art. The citations given are considered relevant to the claimed invention and have been given in the above format because of the interrelated nature of the claim limitations. To help advance prosecution however, the following remarks have been given to help clarify the prior art for applicant.

Provisional application 60/221,042 describes an ETS/system (analogous to the payment enabler) of the claimed invention. As pg. 3 of Applicant's specification (10/26/01) recites, the payment enabler controls the flow of credits through the system. As pgs. 3-4 of provisional application 60/221,042 demonstrates for example, Farris also performs this function. As pgs. 1,5 and 7 of provisional application 60/221,042 demonstrate for example, individuals (analogous to payor/payee) can access machines or kiosks (analogous to the payor computer/payee computer). These machines or

Art Unit: 3693

kiosks (analogous to the payor computer/payee computer) are interfaced to the ETC/system (analogous to the payment enabler). Inherently, pay-out instructions regarding the payee, delivery location and credit amount are received because a designated recipient (analogous to payee) receives the value (analogous to credit amount) at any location domestically or abroad including the device/location used by the payor (analogous to location). See for example, provisional application 60/221,042 at pgs. 26-27

As pg. 4 of Applicant's specification (10/26/01) recites, although the money handler is 'typically' an organization it is not required to be. All that is required of the money handler is that provides an established way to move money; and allows a user to add/remove money from the payment enabler. The types of payments established (analogous to handlers) are described for example on pgs. 3-4 of provisional application 60/221,042

The conversion between these values of the individuals (analogous to the values received from payor/paid to payee) is described for example pgs. 23-27 and 29 of provisional application 60/221,042.

(4) Applicant argues, the prior art reference fails to provide an enabling disclose by arguing there is no mention of an interface between a payee computer and the payment enabler nor between the payor computer and the payment enabler. Farris only mentions kiosks and how the kiosk functions:

Applicant's arguments have been fully considered but they are not persuasive.

Art Unit: 3693

Farris claims benefit to and incorporates by reference in it's entirety provisional application 60/221,042. Contrary to applicants assertions, provisional application 60/221,042 describes an ETS/system (analogous to the payment enabler) of the claimed invention. As pg. 3 of Applicant's specification (10/26/01) recites, the payment enabler controls the flow of credits through the system the system. As pgs. 3-4 of provisional application 60/221,042 demonstrate, Farris also performs this function. As pgs. 1,5 and 7 of provisional application 60/221,042 demonstrate, individuals (analogous to payor/payee) can access machines or kiosks (analogous to the payor computer/payee computer).

(5) Applicant argues, that inherency argument is improper.

Basis in fact and/or technical reasoning was given in prior office action and is noted again below.

Inherently, pay-out instructions regarding the payee, delivery location and credit amount are received because a designated recipient (i.e., payee) receives the value (i.e., credit amount) at any location domestically or abroad including the device/location used by the payor (i.e., location).

As for the new requirement of the delivery location being a residence address. Please note the new grounds of rejection supra.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SARA CHANDLER whose telephone number is (571)272-1186. The examiner can normally be reached on 8-4:30.

Art Unit: 3693

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on 571-272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SMC
/JAGDISH N PATEL/
Primary Examiner, Art Unit 3693